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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,773	08/28/2001	Masaaki Ohashi	1007-011	6753

7590 01/22/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on 12/6/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) 18 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Applicant's election without traverse of claims 1-17 in Paper No. 6 is acknowledged.

2. The drawings are objected to because Figure 3 fails to clearly illustrate a critical element of the invention, namely the fact that silicone based adhesive 3 bonds the fluororesin film 4 to the metal plate 2. Correction is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the claims, particularly claims 1 and 11 fail to properly set forth the disclosed basic structure of the "peeling sheet" of the invention. The proper structure is believed to be a fluororesin film adhered to a metal plate through utilization of a silicone based adhesive, which is clearly a critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See, e.g., page 9, lines 14-17 and Example 2.

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5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, applicant's claims, particularly claims 1 and 11 which set forth the basic structure of the peeling sheet are vague, indefinite and confusing in their present form. The Examiner suggests that the last three lines of claim 1 be amended to read as follows: "a fluoro-resin film adhered with a silicone based adhesive to a portion of the metal plate where the metal plate is at least contacted with or adjacent to the roller." In claims 2 and 12, line 3 of each, the word "essentially" should be deleted from the Markush language. In claims 6 and 16 the word "silicon" should be --silicone--.

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions regarding the prior art as set forth in either Japanese Laid-Open Patent Publication No. 59-188681 or Japanese Laid-Open Patent Publication No. 11-184300 (a complete translation of which has been obtained) as set forth in the specification at pages 2, 3 and 4 of the specification taken either individually, or in view of either Lin et al. or Kobori. Applicant appears to admit in his discussion of the prior art that his essential claimed structure as set forth in independent claim 1 and dependent claim 11 is essentially well known except for the utilization of a silicone based adhesive to adhere the fluororesin film 4 to the metal plate 2. However, the Examiner believes that the utilization of silicone based adhesives is widely known in environments where they are exposed to high temperatures and excessive wear environments. Alternatively, the secondary references each disclose (note particularly Lin et al., column 1, lines 40-47, column 2 lines 1-49, column 5 line 63 - column 6 line 12, column 7 lines 48-52; Kobori, column 1 lines 25-29, column 2 line 18 - column 3 line 4, column 6 lines 3-8, Example 1, Table 1, claims 7 and 9) the utilization of silicone based adhesives in high temperature environments where they are

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required to adhere fluorine containing polymers such as polytetrafluoroethylene and/or metallic foils (Kobori, column 6 lines 3-8) or such coated substrates as metals or fluorocarbon polymers such as polytetrafluoroethylene and polyvinyl fluoride (Lin et al., column 5 line 63 - column 6 line 5) together. Accordingly, one of ordinary skill, motivated by an expectation of improved adhesive performance in high temperature environments would utilize a silicone based adhesive as taught by each of the secondary references as the bonding element in each of the reference structures which applicant admits are known in his specification and thereby either form, or clearly render obvious, the claimed genus of "peeling sheets" and "peeling members". With respect to the dependent claims not encompassed by the above analysis, the particular claimed thickness range as set forth in claims 3 and 13 is believed to be an obvious optimization for one of ordinary skill, and utilization of surface treated fluororesin films and laser spot welding is also believed to be, if not either expressly or inherently disclosed, an obvious modification to one of ordinary skill, in the absence of unexpected results.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Uehara et al. and applicant's patent application publication 2002/0031648A1.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

January 16, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

1700

Daniel Zirker